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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,218	03/29/2001	Richard W. Kay	8030-2	6072
20575	7590	03/23/2006		
MARGER JOHNSON & MCCOLLOM, P.C. 210 SW MORRISON STREET, SUITE 400 PORTLAND, OR 97204			EXAMINER VU, NGOC K	
			ART UNIT	PAPER NUMBER
			2623	

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/823,218

Applicant(s)

KAY ET AL.

Examiner

Ngoc K. Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-18, 20-42, 45-51 and 55-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-18, 20-42, 45-51 and 55-86 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

1. Applicant's arguments with respect to claims 1-11, 13-18, 20-42, 45-51 and 55-86 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 34, 37, 46, 49, and 51 are rejected under 35 U.S.C. 102(e) as being anticipated by Matsuzaki et al. (US 6,289,314 B1).

Regarding claim 34, Matsuzaki teaches a method for delivering digital content, the method comprising:

receiving a request for the digital content (pay information) from a unit (terminal 3) in a multiple unit environment (multiple terminals) at a server (2) (see figures 1-2; col. 14, lines 30-38);

accessing the digital content from a memory (within the server) (see col. 13, lines 55-58);

delivering the digital content to the unit, the delivery of the digital content being independent of an asynchronous delivery of a second digital content to a second unit in the multiple unit environment (delivery of the different pay information to the different terminals – col. 13, lines 61-67; col. 14, lines 38-41);

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accessing a default rate for the digital content (basic charge - see col. 18, lines 50-56; col. 19, lines 61-66);

accessing a custom rate for the digital content (a charge for the pay information based on the coefficient of basic charge - see col. 23, lines 26-48);

accessing a rate key from a user profile (coefficient of basic charge for a user according to attribute of the user such as age, sex, occupation, etc. - see col. 23, lines 26-48); and

selecting the custom rate for the digital content, based on the rate key (the system determines the charge for the pay information based on the coefficient of basic charge for the user according to attributes of the user - see col. 23, lines 26-48).

Regarding claim 37, Matsuzaki teaches that receiving a request includes receiving a request for the digital content from a terminal 3 included a TV set (see col. 14, lines 32-35).

Regarding claim 46, Matsuzaki teaches applying a discount for the digital content (col. 23, lines 24-49; col. 20, lines 19-43).

Regarding claim 49, Matsuzaki teaches sending the pay information from TS to server 2 for storage until requested by the terminal (see col. 25, lines 28-35; col. 14, lines 35-38).

Regarding claim 51, Matsuzaki teaches a computer-readable medium containing a program (software) to deliver digital content, the program being executable on a computer system to implement the method of claim 34 (see and interpretation of claim 34 above).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 35, 36 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuzaki et al. (US 6,289,314 B1).

Regarding claim 35, Matsuzaki teaches providing pay information from provider TS via server (see figures 1-2). Matsuzaki does not teach enabling the terminal to access an internetwork. Official Notice is taken that distributing data from provider to user over Internet is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Matsuzaki by distributing data from provider to users over Internet to provide services to users widely.

Regarding claim 36, Matsuzaki does not explicitly teach distributing video to the terminal. Official Notice is taken that distributing pay information included video to user such as pay-per-view or movie/video on demand services is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Matsuzaki by distributing pay information included video to user to enhance the distribution system.

Regarding claim 45, Matsuzaki teaches accessing the rate key from the user profile stored in the server 2 (see col. 23, lines 25-49). Matsuzaki does not explicitly teach storing the user profile on a second server. Official Notice is taken that storing user profile in a memory at headend or provider is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Matsuzaki by storing user profile in a memory at headend or provider in order to allow operator at the headend or provider accessing user information quicker.

6. Claims 38-42, 47 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuzaki et al. (US 6,289,314 B1) in view of Ellis et al. (US 6,898,762 B2).

Regarding claims 38-42, Matsuzaki does not explicitly teach delivering the content if the content metadata satisfies a filter, conditional accessing the digital content according to content metadata and user profile, and storing user profile in a second server. However, Ellis discloses that server 25 may determine whether a movie or program meets criteria of the user profile to provide to the viewer. For example, movie Armageddon is selected to provide to viewer since it is an action movie and rated as PG-13 according to program information and user profile. The server may use the user profile to filter out undesirable program (see col. 20, lines 26-39; col. 21, lines 16-27). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system Matsuzaki by including conditional accessing program according to program information and user profile as taught by Ellis in order to provide an appropriate program to viewer. Ellis further teaches that user profile is stored in a memory 56 of a server (see col. 6, lines 9-21). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Matsuzaki by storing user profiles in a server as taught by Ellis in order to easily access the profiles at distribution system.

Regarding claims 47 and 48, Matsuzaki does not disclose sending a selected advertisement that matches user profile and storing user profile in a second server. However, Ellis include that the server may target advertising based on user profile (see Ellis: col. 19, lines 64-65; col. 21, lines 29-34). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Matsuzaki by sending targeted advertisement based on user profile to a particular user in order to effectively provide an appropriate advertisement to the user. Ellis further teaches that user profile is stored in a memory 56 of a server (see col. 6, lines 9-21). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Matsuzaki by

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storing user profiles in a server as taught by Ellis in order to easily access the profiles at distribution system.

7. Claims 67-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuzaki et al. (US 6,289,314 B1) in view Gordon et al. (US 20010014975 A1).

Regarding claims 67-86, Matsuzaki does not teach control playing the digital content such as rewind, pause and resume delivery of the digital content from a remote control. However, Gordon teaches the commands for control streaming of the video via the controller 26 to transmission system. The features may include pausing, resuming, fast forwarding, and rewinding the streaming video and/or game (see 0037, 0042, 0045, 0047). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Matsuzaki by for control streaming of the video included pausing, resuming, fast forwarding, and rewinding the streaming video and/or game via the controller 26 to transmission system as taught by Gordon in order to allow the user to control playing video as desired.

8. Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuzaki et al. (US 6,289,314 B1) in view of Hendricks et al. (US 6,539,548 B1).

Regarding claim 50, Matsuzaki teaches accessing a bill for the digital content (see col. 14, lines 38-31). Matsuzaki does not displaying the bill in the unit. However, Hendricks shows a detailed billing information of selected movies on screen of TV (see figures 37a and col. 44, lines 23-30). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Matsuzaki by displaying the bill on the screen of TV in order to allow the user review the bill in a convenient manner.

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9. Claims 1-11, 17, 18, 20-23, 32 and 55-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon et al. (US 20010014975 A1) in view of Matsuzaki et al. (US 6,289,314 B1).

Regarding claim 1, Gordon teaches a system (figure 3) for delivering digital content on demand in a multiple unit environment (multiple viewer receivers), the system comprising:

a server (e.g., 45) local to the multiple unit environment, the server including a memory (90) storing the digital content (viewable data objects may be video including movies, games) and content metadata about the digital content stored in the memory of the server (meta data for a video may be a genre, title, actor/director names), and capable of supporting multiple simultaneous asynchronous accesses to the digital content (capable of supporting multiple requests for video from users from different viewer receivers) (see 0028, 0044, 0052, 0054, 0061, 0070 and figures 3 and 4B);

a billing system (39) for billing each individual unit based on use of the digital content, the billing system coupled to the server (see figure 3; 0051, 0034); and

at least one access system (e.g., settop box) in a plurality of units in the multiple unit environment (multiple viewer receivers), the access system designed to access the digital content stored in the memory on the server (see 0033, 0037, 0067, 0042, 0043, 0054, 0055).

Gordon further discloses that content metadata includes viewing price (see 0028), but does not explicitly disclose a default rate for the digital content and a custom rate for the digital content. However, Matsuzaki teaches providing basic charge of the pay information and discount rate for the pay information to the server 2 (see col. 18, lines 50-56; col. 19, lines 61-66). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Gordon by providing basic charge of the pay

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information and discount rate for the pay information to the server as taught by Matsuzaki for the purpose of charging customer with a reasonable rate.

Regarding claim 2, Gordon teaches providing simultaneous asynchronous delivery of the digital content from the memory on the server (45) responsive to requests from multiple access systems in the units (see 0033, 0037, 0049, 0054, 0055).

Regarding claim 3, Gordon teaches providing simultaneous asynchronous delivery includes software designed to read the digital content from the memory on the server and transmit the digital content to the unit (see 0060-0063).

Regarding claim 4, Gordon teaches controls for pausing the digital content (see 0045).

Regarding claim 5, it is noted that controlling for randomly accessing the content such as play forward or backward. Therefore, the limitations are met by features of commands such as fast forwarding, rewinding...etc as disclosed by Gordon (see 0045).

Regarding claim 6, Gordon teaches that the digital content includes content available on server 43, 44 (see 0054).

Regarding claim 7, Gordon teaches that the digital content includes video (see 0031).

Regarding claim 8, Gordon teaches that the access system includes a set top box (23) designed to enable access to the digital content, the set top box coupled to the server and to a display (24) in the unit (see figures 1-2; 0042).

Regarding claim 9, Gordon teaches that the set top box is coupled to the server via a switching hub for a network, the switching hub designed to allow a plurality of units to access the server (see 0058).

Regarding claim 10, Gordon teaches that the set top box is designed to allow access to a non-digital content (e.g., text) displayed on the display (see 0031, 0033).

Regarding claim 11, Gordon teaches that the set top box includes a handset (26 – see figure 2; 0042).

Regarding claim 17, Gordon discloses that metadata for game includes ratings (see 0028).

Regarding claim 18, Gordon as modified by Matsuzaki further teaches that the server includes user metadata such as attributes of the user or user information (see Matsuzaki: col. 23, lines 25-48).

Regarding claim 20, the combined system of Gordon and Matsuzaki further teaches that the system comprises user profile including a rate key (coefficient of basic charge for a user according to attribute of the user such as age, sex, occupation, etc. – see Matsuzaki: col. 23, lines 26-48), and the system is designed to use the custom rate when the rate key identifies the customer rate (the system determines discount according to attributes of the user – see Matsuzaki: col. 23, lines 26-48).

Regarding claims 21 and 22, Gordon as modified by Matsuzaki further teaches that the user information is stored in the server 2 (see col. 23, lines 25-49). Gordon and Matsuzaki do not explicitly teach storing the user profile in a memory on a second server and retrieving the user profile from a memory on a second server. Official Notice is taken that storing user profile in a memory and retrieving the stored user profile from the memory at headend or provider are well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Matsuzaki by storing user profile in a memory and retrieving the stored user profile from the memory at headend or provider in order to allow operator at the headend or provider accessing user information quicker.

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Regarding claim 23, Gordon as modified by Matsuzaki further teaches that a discount rate (i.e., 5%) can be applied in addition to the default rate (basic charge) (see col. 20, lines 8-43).

Regarding claim 32, Gordon further teaches a second sever (44) offsite from the multiple unit environment (see figure 3), the second server coupled to the server (45) to provide digital content to the server (see 0054).

Regarding claims 55-66, Gordon teaches the commands for control streaming of the video via the controller 26 to transmission system. The features may include pausing, resuming, fast forwarding, and rewinding the streaming video and/or game (see 0037, 0042, 0045, 0047).

10. Claims 13-16, 24-31 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon et al. (US 20010014975 A1) in view of Matsuzaki et al. (US 6,289,314 B1) and further in view of Ellis et al. (US 6,898,762 B2).

Regarding claim 13, 14, 16, 29 and 30, Gordon as modified by Matsuzaki further teaches that user information is stored in the server 2 (see Matsuzaki: col. 23, lines 25-49). Both fail to teach conditional accessing the digital content according to content metadata and user profile. However, Ellis discloses that server 25 may determine whether a movie or program meets criteria of the user profile to provide to the viewer. For example, movie Armageddon is selected to provide to viewer since it is an action movie and rated as PG-13 according to program information and user profile. The server may use the user profile to filter out undesirable program (see col. 20, lines 26-39; col. 21, lines 16-27). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Gordon and Matsuzaki by including conditional accessing program according to program information and user profile as taught by Ellis in order to provide an appropriate program to viewer.

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Regarding claims 24, 27 and 28, the combined system of Gordon and Matsuzaki and Ellis include that the server may target advertising based on user profile (see Gordon: 0067; Ellis: col. 19, lines 64-65; col. 21, lines 29-34).

Regarding claims 15, 25, 26, 31 and 33, Gordon as modified by Matsuzaki further teaches that the user information is stored in the server 2 (see col. 23, lines 25-49). Gordon and Matsuzaki do not explicitly teach storing and updating the user profile in a memory on a second server, and retrieving the user profile from a memory on a second server. Official Notice is taken that storing user profile in a memory and retrieving the stored user profile from the memory at headend or provider are well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Matsuzaki by storing and updating user profile in a memory and retrieving the stored user profile from the memory at headend or provider in order to allow operator at the headend or provider to maintain user profile easily and access user profile quicker.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoc K. Vu whose telephone number is 571-272-7306. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ngoc K. Vu
Primary Examiner
Art Unit 2611

March 20, 2006